

REMARKS/ARGUMENTS

The Office Action dated March 31, 2006 has been received and carefully considered. The application has been amended to more clearly describe the present invention. No new matter has been added. The pending and amended claims overcome the rejections of claims 1-18 based on the applied references. Reconsideration of the outstanding rejections is respectfully requested based on the following remarks.

I. REJECTIONS UNDER 35 U.S.C. § 101

Claims 1-12 have been rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Specifically, the Office Action asserts that a “markup language” in claim 1 and an “active voice page” in claim 7 are “programs”, which are allegedly “neither computer components nor statutory processes”. See Office Action at page 3-4. As suggested by the Office Action, claim 1 has been amended to specify a “computer-readable storage medium comprising code programmed in a markup language” and claim 7 has been amended to specify an “active voice page in a computer-readable storage medium”. In view of the forgoing, Applicants respectfully submit that claims 1-12 are directed to patentable subject matter and therefore request that the rejection be withdrawn.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-5 and 7-12 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the Motorola VoxML 1.1 Language Reference (“Motorola”) in view of U.S. Patent No. 6,449,496 to Beith et al. (“Beith”). Claims 6 and 12 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Motorola in view of Beith, and further in view of Applicant’s Admitted Prior Art (“AAPA”). Claims 13-17 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Motorola in view of Beith, and further in

view of U.S. Patent No. 6,269,336 to Ladd et al. ("Ladd"). Claim 18 has been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Motorola in view of Beith, in further view of Ladd, and further in view of AAPA. Applicants respectfully traverse these rejections.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in

judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970).

The Office Action fails in all of the above rejections to set forth a proper *prima facie* case of obviousness.

First, while the Office recognizes that the Motorola reference does not disclose or suggest an n-best list filter element in an XML-based language structure as recited in the claims, it presumes that Beith remedies this deficiency because it alleges “a method for requesting verification from a list of possible matches for an audibly-uttered user response”. See Office Action at p. 6. However, Applicants respectfully submit that **Beith does not disclose, suggest, or even contemplate “an n-best list filter element”**. The mere disclosure of a method for requesting verification from a list is not the same as an n-best list filter element recited in the claims. Accordingly, Applicants respectfully submit that not all of the claimed limitations are taught in the references.

Second, the PTO asserts that modifying the Motorola reference to include the n-best list filter feature would have been obvious “because such feedback greatly improves the accuracy and increases the user confidence in the system.” See Office Action at p. 6. However, such a statement represents classic **impermissible hindsight**. The Office Action fails to provide any ***evidence*** as to why one of ordinary skill in the art would choose to implement the n-best list element in the way claimed. Instead, the Examiner relies on his own hindsight conjecture. Apparently, the Office Action’s statement that it would greatly improve accuracy and increase user confidence in the system is wholly unsupported. None of the references cited in the Office Action states anywhere that there is an advantage in adding an element in the XML-based language.

The Office Action's modification of Motorola and Beith in view of the other cited references – AAPA and Ladd – suffers from similar flaws. For example, in claims 6 and 12, the Office acknowledges that neither Motorola nor Beith discloses “an error announcement is made when a match is not found.” *See* Office Action on p. 7. The PTO asserts that AAPA remedies this deficiency because it is supposedly “notoriously well known...to provide the user with an announcement that no match has been found, such as “I did not understand” or requesting the user to repeat the utterance”. *See* Office Action at p. 7. However, AAPA does not disclose the recitation as alleged by the Office nor does the AAPA support this conclusion as a whole. Rather, Applicants respectfully submit that the PTO gleaned from Applicant's Detailed Description on page 2, the only section that recites “I did not understand”, to improperly construct the motivation. Thus, absent further evidence, the Office has clearly failed to meet its *prima facie* burden.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-18 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

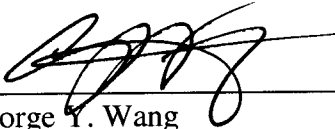
To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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